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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,958	08/04/2003	Takeshi Ikeda	03500.017465	4484

5514 7590 04/23/2007
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HENN, TIMOTHY J

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/632,958	IKEDA, TAKESHI	
	Examiner	Art Unit	
	Timothy J. Henn	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-6 and 12-15 in the reply filed on 10 January 2007 is acknowledged. The traversal is on the ground(s) that the two groups are closely related and a search of one group would likely include a search of the other group. This is not found persuasive because a search of the claims corresponding to group I would not require a search of driving an iris mechanism in response to changing an image size, while a search of the second group would necessarily require searching for that feature. Therefore, since the necessary search for group I does not encompass the necessary search for group II or vice versa, Applicants arguments are not considered persuasive. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7-9 and 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10 January 2007. While claims 10 and 11 were originally included in group II in the restriction requirement, the examiner notes that these claims should have been included in group I since they are dependent on claim 2. Therefore, claims 10 and 11 (which are substantial duplicates of claims 3 and 4) will not be withdrawn from further consideration.

Drawings

3. Figures 8 and 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernest et al. (EP 0340678 A2).

[claim 1]

Regarding claim 1, Ernest discloses an image pickup apparatus (Figure 3) capable of photographing with changing over a first mode for recording a plurality of frames (i.e. video) and a second mode for recording one frame (i.e. still image) in accordance with a predetermined action (e.g. c. 2, l. 41 - c. 3, l. 20), comprising: an iris mechanism for changing an amount of light with which an image pickup element is

Art Unit: 2622

irradiated (Figure 3, Item 14); a filter unit for changing the amount of the light input (Figure 3, Item 24, Figures 5-12); and a driving unit for driving the iris mechanism and the filter unit independently (Figure 3, Items 16 and 26), wherein the driving unit drives the filter unit in different manners between the first mode and the second mode (c. 2, l. 41 - c. 3, l. 20).

[claim 2]

Regarding claim 2, Ernest discloses an image pickup apparatus (Figure 3) capable of photographing with changing over a first mode for recording a plurality of frames (i.e. video) and a second mode for recording one frame (i.e. still image) in accordance with a predetermined action (e.g. c. 2, l. 41 - c. 3, l. 20), comprising: an iris mechanism for changing an amount of light with which an image pickup element is irradiated (Figure 3, Item 14); a filter unit, having a single density or a plurality of densities, for changing an amount of incident light (Figure 3, Item 24, Figures 5-12); a unit for driving the iris mechanism and the filter unit independently (Figure 3, Items 16 and 26); and a control unit for setting, in the second mode, the filter unit in one of states of covering an aperture diameter of the iris mechanism and of withdrawing the aperture diameter of the iris mechanism (Figure 3, Items 26 and 28; c. 6, ll. 6-50; Figures 7-12).

[claim 3]

Regarding claim 3, Ernest discloses a control unit which performs drive control of the filter unit so that the filter unit is driven from the state of withdrawing from the aperture diameter of the iris mechanism to the state of covering the whole of the aperture diameter, when the aperture diameter of the iris mechanism is changed so as

Art Unit: 2622

to be opened in the second mode and the aperture diameter reaches a predetermined aperture diameter (i.e. capturing an image by opening and closing the shutter with a set aperture diameter; c. 5, l. 5 - c. 8, l. 33).

[claim 4]

Regarding claim 4, Ernest discloses a control unit which performs drive control of the filter unit so that the filter unit is driven so as to withdraw from the state of covering the aperture diameter, when the aperture diameter of the iris mechanism is changed so as to be closed up in the second mode and the aperture diameter reaches a predetermined aperture diameter (i.e. capturing an image with a small aperture setting; c. 5, l. 5 - c. 8, l. 33).

[claim 5]

Regarding claim 5, Ernest discloses an image pickup apparatus (Figure 3) capable of photographing with changing over a first mode for recording a plurality of frames (i.e. video) and a second mode for recording one frame (i.e. still image) in accordance with a predetermined action (e.g. c. 2, l. 41 - c. 3, l. 20), comprising: an iris mechanism for changing an amount of light with which an image pickup element is irradiated (Figure 3, Item 14); a filter unit, having a single density or a plurality of densities, for changing an amount of incident light (Figure 3, Item 24, Figures 5-12); a unit for driving the iris mechanism and the filter unit independently (Figure 3, Items 16 and 26); and a control unit for performing drive control of the filter unit so that the filter unit is driven from a state in which a first density area of the filter unit withdraws from the aperture diameter of the iris mechanism to a state in which the first density area of

Art Unit: 2622

the filter unit covers the aperture diameter when the aperture diameter of the iris mechanism is changed so as to be opened in the second mode and the aperture diameter reaches a predetermined aperture diameter (capturing an image by opening and closing the shutter with a set aperture diameter; Figure 3, Items 26 and 28; Figures 7-12; c. 5, l. 5 - c. 8, l. 33).

[claim 6]

Regarding claim 6, Ernest discloses an image pickup apparatus (Figure 3) capable of photographing with changing over a first mode for recording a plurality of frames (i.e. video) and a second mode for recording one frame (i.e. still image) in accordance with a predetermined action (e.g. c. 2, l. 41 - c. 3, l. 20), comprising: an iris mechanism for changing an amount of light with which an image pickup element is irradiated (Figure 3, Item 14); a filter unit, having a single density or a plurality of densities, for changing an amount of incident light (Figure 3, Item 24, Figures 5-12); a unit for driving the iris mechanism and the filter unit independently (Figure 3, Items 16 and 26); and a control unit for performing drive control of the filter unit so that the filter unit is driven from the state in which a first density area of the filter unit covers the aperture diameter of the iris mechanism to a state in which the first density area of the filter unit withdraws from the aperture diameter when the aperture diameter of the iris mechanism is changed so as to be closed up in the second mode and the aperture diameter reaches a predetermined aperture (capturing an image with a small aperture setting; Figures 7-12; c. 5, l. 5 - c. 8, l. 33).

[claims 10 and 11]

Regarding claims 10 and 11, see claims 3 and 4.

[claims 12-15]

Claims 12-15 are method claims corresponding to apparatus claims 1, 2, 5 and 6. Therefore, claims 12-15 are analyzed and rejected as previously discussed with respect to claims 1, 2, 5 and 6.

Double Patenting

6. Applicant is advised that should claims 3 and 4 be found allowable, claims 10 and 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

i. Ernest et al.

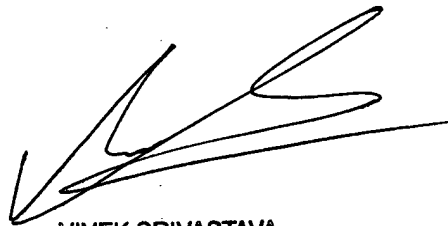
US 4,827,348

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Henn whose telephone number is (571) 272-7310. The examiner can normally be reached on M-F 11-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJH
4/14/2007



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